

***United States Court of Appeals  
for the Second Circuit***



**BRIEF FOR  
APPELLEE**





76-7563

*To Be Argued by* PETER L. COSTAS  
*Attorney for Appellee*

**United States Court of Appeals**

FOR THE SECOND CIRCUIT

DAVID COHN,

*Plaintiff-Appellant,*

against

COLECO INDUSTRIES, INC.,

*Defendant-Appellee*

APPEAL FROM AN ORDER AND JUDGMENT OF THE UNITED STATES  
DISTRICT COURT FOR THE SOUTHERN DISTRICT OF NEW YORK

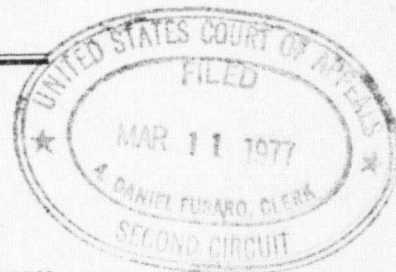
**BRIEF FOR DEFENDANT-APPELLEE**

PETER L. COSTAS  
Three Lewis Street  
Hartford, Connecticut 06103  
(203) 278-9892

FORSYTHE, LEVINNESS & PEARSON  
STANLEY L. KANTOR  
375 Park Avenue  
New York, New York 10022  
(212) 759-4300

*Attorneys for Appellee*  
*Coleco Industries, Inc.*

Dated: March 8, 1977  
At: Hartford, Connecticut



## TABLE OF CONTENTS

I. PRELIMINARY STATEMENT	1
II. QUESTIONS PRESENTED FOR REVIEW	1
III. STATEMENT OF THE CASE	2
A. Statement of Prior Proceedings	2
B. Statement of Facts	6
1. The Cohn Patent No. 3,019,020	7
2. The Prosecution of the Cohn Application Before the United States Patent Office	9
3. The Accused COLECO Bowling Game	16
IV. POINTS ON APPEAL	20
Summary Judgment May Be Granted Where There Is No Genuine Issue of Material Fact	21
Cohn Has Admitted That the Claims Do Not Literally Read Upon the Coleco Structure	22
The Distinctions of the COLECO Game May Also Be Observed Independently	27
COHN Admits and The Record Shows That the Claims Were Successively Narrowed in Scope in Order to Obtain Allowance	27
The Specification of the COHN Patent Must Be Used to Interpret the Claims	29
The Accused Coleco Game Does Not Infringe the Claims of the Cohn Patent	31
V. CONCLUSION	36



# TABLE OF CITATIONS

Arvin Industries, Inc. v. Berns Air King Corp., 525 F.2d 182 (7th Cir. 1975)	32
Burgess & Associates, Inc. v. Klingensmith, 487 F.2d 321 (9th Cir. 1973)	32
Capri Jewelry Incorporated et al v. Hattie Carnegie Jewelry Enterprises, Ltd. et al, 539 F.2d 846 (1976)	34
General Instrument Corporation v. Hughes Aircraft Company, 399 F.2d 373 (1st Cir. 1968)	32
Graham et al v. John Deere Company et al, 383 U.S. 1 (1966)	32
Heyman v. Commerce and Industry Insurance Co., 524 F.2d 1317, 1319 (2d Cir. 1975)	22
International Latex Corporation v. Warner Brothers Company, 276 F.2d 557 (2d Cir. 1960)	32, 33, 34
Kaiser Industries Corp. et al v. McLouth Steel Corporation 400 F.2d 36 (6th Cir. 1968)	32
MacLaren v. B-I-W Group, Inc., 535 F.2d 1367 (2d Cir. 1976)	29
Mastini v. American Telephone & Telegraph et al 269 F.2d 378 (1966)	22
Moore Business Forms, Inc. v. Minnesota Mining and Manuf. Co., 521 F.2d 1178 (2d Cir. 1975)	35
Pittway Corp. v. Trine Mfg. Corp., 183 U.S.P.Q. 675 (SDNY 1974)	22, 32
Power Curbers Inc. v. E.D. Etnyre & Co. et al 298 F.2d 484 (4th Cir. 1962)	32
Rosen v. Kahlenberg, 474 F.2d 858 (5th Cir. 1973)	32
Schriber-Schroth Co. v. Cleveland Trust Co., 311 U.S. 211 (1940)	29, 32

Schmidinger et al v. Welsh et al, 383 F.2d 455 (3rd Cir. 1967)	32
Svenska Aeroplan Aktiebolaget v. Mergenthaler Co., 410 F.2d 979 (2d Cir. 1969)	31
U.S. v. Adams, 383 U.S. 39 (1966)	29
U.S. Philips Corp. v. National Micronetics, Inc., 410 F.Supp. 449 (SDNY 1976)	29
Vermont Structural Slate Co. v. Tatko Bros. Slate Co., 233 F.2d 9 (2d Cir. 1956)	22

#### TABLE OF STATUTES AND OTHER AUTHORITY

Federal Rules of Civil Procedure, Rule 56	21
Moore's Federal Practice, Para. 56.17 [44] (2d Ed. 1974), page 2613 et seq.	22



## I. PRELIMINARY STATEMENT

This is an appeal under 28 U.S.C. 1291 taken by Plaintiff-Appellant from the Judgment of the Honorable Whitman Knapp, United States District Judge for the Southern District of New York, granting Defendant-Appellee's Motion for Summary Judgment of Noninfringement of the patent in suit (Appendix at 18-182). Judgment was entered on October 12, 1976 (Appendix at 253) based upon the Memorandum and Order dated August 5, 1976 (Appendix at 251-252) following a hearing on Defendant's motion held before the Honorable Whitman Knapp on June 11, 1976. Neither the Memorandum and Order nor Judgment of the Honorable Whitman Knapp have been reported in any publication.

## II. QUESTIONS PRESENTED FOR REVIEW

A. Do the claims of Plaintiff-Appellant's patent read upon the structure of Defendant-Appellee's accused games?

B. Did Plaintiff-Appellant narrow the scope of the claims of his patent application during prosecution before the United States Patent Office in order to obtain allowance thereof?

C. Were limitations in the patent claims which do not literally read upon Defendant-Appellee's accused game added during prosecution before the United States Patent Office in order to obtain allowance?

D. Did Plaintiff-Appellant argue a narrow scope for his patent claims in order to obtain allowance and is he now attempting to expand those claims in an effort to encompass Defendant-Appellee's accused games?

E. Does the Doctrine of File Wrapper Estoppel effectively foreclose the application of the Doctrine of Equivalents and thus Plaintiff-Appellant's efforts to reconstruct its claims so as to encompass Defendant-Appellee's accused product?

F. Is there any genuine issue as to any material fact relevant to the matter presented on appeal?

### III. STATEMENT OF THE CASE

#### A. Statement of Prior Proceedings

Plaintiff-Appellant DAVID COHN (hereinafter COHN) commenced this action for patent infringement by filing of a complaint and summons in the United States District Court for the Southern District of New York on May 1, 1975. In the complaint, Defendant-Appellee COLECO INDUSTRIES, INC. (hereinafter COLECO) was charged with infringement of Cohn United States Letters Patent No. 3,019,020 issued on January 30, 1962 for a "bowling game" and COHN sought an injunction from further infringement of said Letters Patent, an accounting for profits of Coleco and damages suffered by Cohn as a result of the alleged infringement, trebling of damages, such other and further relief as the Court might deem just and proper, costs, disbursements and attorneys' fees (Appendix at 4-6).



On May 24, 1975, COLECO filed answer and counterclaim to the complaint herein (Appendix at 7-13) in which it denied infringement of the COHN patent in suit and counterclaimed for declaratory judgment of invalidity and noninfringement. COLECO prayed for judgment dismissing the complaint, declaring the COHN patent invalid and void and not infringed, and enjoining COHN, his agents and employees from enforcing or attempting to enforce the patent, assessing costs and attorney's fees for filing of the present action without justification, and such other and further relief as might be just.

On June 6, 1975, COHN replied to the counterclaim denying the allegations of invalidity and noninfringement (Appendix at 14-17).

COHN filed his first set of interrogatories to COLECO on November 11, 1975 and COLECO filed its answers on January 9, 1976 (Appendix at 3).

COLECO filed a request for admissions on April 5, 1976 and COHN responded thereto; a composite of the request for admissions and the response thereto is set forth in the Appendix at pages 100-113.

COLECO filed interrogatories to COHN on April 7, 1976 and COHN answered such interrogatories; a composite of the interrogatories and of the answers thereto is set forth in the Appendix at pages 114-129.

COLECO took the deposition of COHN on November 11, 1975 and excerpts from the transcript of that deposition appear in the Appendix at pages 232-248. During the course of the deposition, there was testimony and exhib-

its were marked establishing that COHN's counsel had, prior to the institution of the present action, charged COLECO with infringement (Appendix at 170) and that COLECO's counsel had advised COHN's counsel of some of the reasons why the COLECO game did not infringe (Appendix at 172-173).

On May 17, 1976, COLECO brought its Motion for Summary Judgment of Noninfringement of the COHN patent in suit on the basis of file wrapper estoppel and COLECO further sought an award of attorney's fees on the basis that the action had been frivolously brought (Appendix at 18-19). Supporting its motion were a memorandum (Appendix at 20-39); a copy of the COHN patent in suit (Appendix at 40-44); a copy of the file history of the application which matured into the COHN patent in suit (Appendix at 45-99); the composite of the request for admissions and the COHN response (Appendix at 100-113); the composite of the interrogatories to COHN and his response thereto (Appendix at 114-129); a copy of Lloyd United States Patent 2,217,063 which was cited by the United States Patent Office Examiner against the COHN application (Appendix at 103-136); a copy of Igou Patent 1,913,673 which was cited by the United States Patent Office Examiner against the COHN application (Appendix at 137-141); a chart comparing the claims of the COHN application as filed with the claims of the COHN patent as issued (Appendix at 142-145); a copy of the COLECO patent 3,866,691 granted upon the application of Richard Freeman and directed to the accused game (Appendix at 146-157); a colored reproduction of one of the illustrations of the COHN patent and several of the illustrations of the COLECO Freeman patent (Appendix at 158) together with a chart



showing the contentions of COHN's attorney as to those elements of the COLECO structure which responded to the limitations of the COHN patent and a key to the colors employed upon the colored reproduction of the illustrations (Appendix at 159-160); the extract of the transcript of the COHN deposition (Appendix at 161-169); a copy of the correspondence prior to suit which had been marked as exhibits during the COHN deposition (Appendix at 170-173); and the Statement of Material Facts Under Local Rule 9(g) (Appendix at 179-182).

COHN filed a Memorandum in Opposition to the motion on June 10, 1976 (Appendix at 208-215) together with an affidavit of William Slinger (Appendix at 183-207); an excerpt of the transcript of the deposition of the COLECO game inventor Richard Freeman taken on May 24, 1976 (Appendix at 216-222); a copy of the Lloyd and Igou patents (Appendix at 230-231 but reproduced in Appendix at 130-141); an excerpt from the transcript of the deposition of COHN (Appendix at 232-248); and a Statement of Material Facts Under Local Rule 9(g) (Appendix at 249-250).

The motion was orally argued before the Honorable Whitman Knapp on June 11, 1976, and counsel for COHN produced at the hearing a reconstructed version of the accused game for purposes of attempting to show the "equivalence" of parts of the reconstructed accused game to the claims of the COHN patent in suit. Counsel for Coleco then produced a model of the accused game as actually made and sold by COLECO.

On August 5, 1976, the Honorable Whitman Knapp issued his Memorandum and Order (Appendix at 251-252) granting the Motion for Summary Judgment in which he found, inter alia, that the patent was granted only after having been narrowed by several amendments, that the coverage of the patent was restricted, that the Doctrine of Functional Equivalents could not be used to extend the scope of protection, that there was no dispute as to the fact that the accused game did not contain certain of the structural limitations of the patent and therefore did not infringe. The Court further found that the structural limitations in question were specifically added to the patent claims in order to gain allowance of the patent and that therefore there could be no equivalent protection. Lastly, the Court found that the action was not so exceptionally unfounded as to necessitate an award of attorneys' fees.

On October 12, 1976, the Court entered judgment dismissing the action on the merits and denying COLECO's request for attorneys' fees, while awarding COLECO costs (Appendix at 253).

From this judgment COHN has taken the present appeal.

#### B. Statement of Facts

For convenience, the factual background underlying the Motion for Summary Judgment will be set forth briefly hereinafter although it is believed that the focal issue on the present appeal is the question of law as to whether a patentee may seek to expand the scope of his patent claims to en-



compass an accused product which is not encompassed by the literal language of the claims through an argument that limitations added and argued to obtain allowance of the patent are nevertheless entitled to broadening under the Doctrine of Equivalents. COLECO at no time has conceded that its structural elements are equivalents to those defined in the claims and it will not now address itself to such factual questions since they need not be reached and resolved.

1. The Cohn Patent No. 3,019,020

The COHN patent in suit was granted on January 30, 1962 with two independent claims (Claims 1 and 4) and two dependent claims (Claims 2 and 3). It was based upon an application filed on October 20, 1958 and is classified in Class 243 at Subclass 44.

The structure of the COHN patent is shown in the drawings at Appendix pages 40-41 and the structure is described in detail in the specification at Appendix pages 42-43.

As defined in the claims of the COHN patent, the alleged invention may be described broadly as comprising a toy bowling game which has a flat, substantially rectangular shaped metal base plate 10 (the pertinent numerical references from the patent specification are utilized herein) of magnetic material which has an extensive upper surface and upstanding flanges 11 integral with its side edges. Extending over one end of the base plate 10 is an inverted U-shaped frame 13 which has the flat cross piece 16 and a pair of

uprights 14 which are joined to the flanges 11 of the base plate 10, thus providing "...an enclosure which is open at both the front and the rear" (Appendix at 42, column 2, lines 19-21). Mounted on the U-shaped frame 13 is a triangular-shaped guide plate 34 which has openings 44 spaced thereabout. Spaced above the guide plate 34 is the supporting member 32 which is mounted for vertical movement relative to the base plate 10 and guide plate 34. Springs 36 disposed about the plunger rods 35 bias the supporting plate upwardly away from the base plate 10 and guide plate 34.

The bowling pins 20 are connected to the supporting member 32 by elastic strings 30, and they have a permanent magnet 22 in the base thereof to enable the bowling pins 20 to be attracted to the base plate 10. As described in the specification and as functionally indicated in the claims, the elastic strings 30 are of such a length that they will maintain the bowling pins 20 raised above and out contact with the base plate 10 when the strings 30 are only slightly extended; when more fully extended, the strings 30 will permit the magnets 22 in the base portions of the bowling pins 20 to contact the metal base plate 10.

The pins 20 are supported in an upright position on the base plate 10 when the supporting member 32 is depressed towards the guide plate 34 and base plate 10 against the biasing action of the springs 36 so that the magnetic attraction between the magnets 22 and the metal base plate 10 keeps the pins in assembly thereon as the supporting plate 32 is moved upwardly with the elastic strings 30 elongated. As indicated, the springs 35 bias or



push the supporting member 32 upwardly and retain it in a spaced relationship above the base plate 10 and the guide plate 34.

Both Claims 1 and 4 define a structure as indicated above. Claims 2 and 3 further define the structure of the supporting member.

The actual limitations of Claims 1 and 4 broken down into component parts are set forth in the right hand column of the table appearing at Appendix pages 142-145.

## 2. The Prosecution of the Cohn Application Before the United States Patent Office

As originally filed in the United States Patent Office, the patent application included the specification and drawings of the patent as issued, together with sixteen claims. Claim 1-3 as filed were directed to a bowling pin; Claims 4-15 were directed to a bowling game assembly; and Claim 16 was an omnibus claim of a nonstatutory type (Appendix at 49-53). Claims 4 and 15 were independent claims and Claims 5-14 depended either directly or indirectly on Claim 4.

The first action by the Patent Office was a requirement for restriction, i. e., a requirement that the application be limited to one of three difference categories of subject matter in accordance with Patent Office classification (Appendix at 57-58). In response to this requirement for restriction, nonstatutory Claim 16 was cancelled and provisional election was made of the claims drawn to the bowling game assembly, i. e., Claims 4-14 (Appendix at 59-60).

The Examiner then searched the prior art and rejected Claims 4-14 as unpatentable over Lloyd United States Patent 2,217,063 either alone (Claims 4 and 5), or in combination with Hedenskoog Patent 2,348,540 (Claims 6-8), or in combination with Hedenskoog and Dicker Patent 2,819,902 (Claims 9-11 and 13-14), or in combination with Jaufroid Patent 1,058,062 or Lemon Patent 2,900,188 (Claim 12). Igou United States Patent 1,913,673 (Appendix at 137-141) was cited as showing the spring-biased seating mechanism. The Lloyd patent appears at Appendix pages 130-136.

As can be seen from Claim 4 of the application as filed (Appendix at 142-143), the broadest independent claim to the toy bowling game required, inter alia:

- a flat metal base of magnetic material with an extensive upper surface;
- a supporting member secured to the base and extending thereover in spaced relationship;
- a bowling pin with a permanent magnet in its base; and
- an elastic string secured to the tip of the bowling pin and to the supporting member which extended over the base with the elastic string having a length and extensibility to permit the permanent magnet in the bowling pin base to secure the pin in position on the metal base and to draw the pin upwardly when the pin was struck by the ball to move it outwardly from contact with the metal base.



The Examiner's rejection was predicated upon the fact that the Lloyd patent described a toy bowling game which included a flat base 10,38 with magnets 11 disposed in the member 10; a supporting member 28 secured to the base 10, 38 by the stanchions 27 and which extended thereover in spaced relationship; a bowling pin 29 with a metallic element 31 in its base; and an elastic string 33 secured to the base of the bowling pin and to a bracket 30 mounted on the supporting member 28. The Examiner took the position that reversal of the magnet and metallic elements from base of pin to flat base, and flat base to pin respectively, and movement of the elastic string to the top of the bowling pin rather than the bottom of the bowling pin, was not inventive and of patentable significance (Appendix at 69).

In response to this Official Action, independent Claim 4 was cancelled and a new independent Claim 17 was introduced, which incorporated a number of additional limitations which had not appeared in original Claim 4:

the supporting member was further defined as being spring urged and mounted for movement relative to the base plate;

the bowling pin was defined as being carried by the supporting member;

the bowling pin was defined as being supported in upright position on the base plate when the supporting member was depressed towards the base plate;

the magnet was defined as resisting removal of the pin from the base plate when the supporting member was returned to its original position; and

the supporting member was defined as automatically returning to and as normally retained in its spaced relation above the base plate.

(Appendix at 73-74). This is admitted by COHN in response to Request for Admission No. 31 (Appendix at 109-110).

The attorney argued the distinctions of these limitations over the prior art and stated in summary:

"Thus, new claim 17 specifically calls for a spring-urged supporting member carrying a bowling pin and mounted for movement relative to the base plate and automatically returning and being retained in normal spaced relation above said base plate."

(Appendix at 74-79).

Following consideration of this amendment, the Examiner again rejected all claims of the application under consideration (Appendix at 80-81). Claims 5, 7 and 17 were rejected as unpatentable over Lloy in view of Hedenskoog because the Examiner still did not consider the reversal of the magnet and metallic base relationships as patentable, and he did not accord any patentable consideration to the functional statements of the claim. He also rejected Claims 5, 7 and 17 as unpatentable over Lloyd in view of Igou because he felt it would be obvious to spring bias the pin seating support means of Lloyd in an upward direction in view of the teachings of Igou. This rejection was a final rejection of the claims under consideration.



In response to this rejection, certain amendments were proposed to Claims 5 and 17 and Claim 7 was to be cancelled (Appendix at 83; see also response to Request for Admission No. 36, Appendix at 111). The attorney argued that Claim 17 was being amended to add "...as a positive element the spring means normally urging said supporting member away from said base plate". The attorney further argued that Claim 17 as amended would call for a supporting member mounted for movement relative to the base plate and spring means for normally urging the supporting member away from the base plate plus a characterization of the spring means as acting to urge the supporting member to return to and be retained in a normally spaced relationship above the base plate. Thus, the attorney argued the claim as it would be amended would "...distinguish from Lloyd both in substance and language". The attorney made many additional arguments with respect to the differences over Lloyd and Igou stressing structural features of the claims (Appendix at 84-86).

In the Official Action dated April 21, 1961, the Examiner refused to enter the proposed amendments since they did not place the application in condition for allowance and he reaffirmed the rejection of Claims 5 and 17 as unpatentable over Lloyd in view of Igou while withdrawing the rejection based upon unpatentability over Lloyd in view of Hedenskoog (Appendix at 87-88).

There then followed an interview between the COHN attorney and the Examiner and the submission of a new amendment in which Claim 17 was

cancelled and new Claim 18 was substituted therefor (Appendix at 89-91).

Application Claim 18 is identical to Claim 1 of the COHN patent and included the following additional limitations which had not previously existed in former Claim 17 and which were added to distinguish over the prior art:

the base plate 10 was defined as having upstanding flanges 11 integral with the opposite side edges thereof;

there was added to the claim an inverted U-shaped frame 13 which was defined as extending over the base plate 10 in spaced relation thereto and as having its lower opposite edges secured to the flanges 11 on the base plate 10;

there was added a substantially triangular shaped guide plate 34 which was defined as having relatively spaced openings 44 therein and as mounted on the U-shaped frame 13;

the supporting member 32 was defined as being positioned above the guide plate 34 and spaced therefrom; and

the spring means 35 was further defined as being positioned intermediate the guide plate 34 and supporting member 32 for normally urging the support member 32 away from the base plate 10.

(Appendix at 142-143). This is admitted by COHN in response to Requests for Admissions Nos. 38 and 39 (Appendix at 111-112).

In the Remarks section of the amendment, the attorney stated, "Claim 17 has been amended to more specifically define Applicant's invention and is now being presented as Claim 18 for the consideration of the



Examiner." Inter alia, he stated that the new claim specifically defined the subplate 39 [sic] as the supporting member to which the elastic strings were connected and that the springs urged this supporting member away from the base. He argued that the springs defined in the claim pushed the plate upwardly whereas the springs of the Igou patent pulled the plate upwardly. He indicated that the Examiner appeared to favor allowing the new claim since it defined allowable subject matter over the prior art patents.

In an amendment filed on May 12, 1961, following another interview with the Examiner, Claim 19 was added and the nonelected claims were cancelled. This new claim was represented as being "...of similar scope to Claim 18..." (Appendix at 94-96). The component limitations of new Claim 19 which became Claim 4 of the patent are shown in tabular form at Appendix pages 144-145 and are seen to parallel the component limitations of Claim 4 of the application which became Claim 1 of the patent.

Following this amendment, the Examiner allowed the application (Appendix at 98) and the patent subsequently issued.

There can be no question that during the prosecution of the COHN application before the United States Patent Office that broad claims to a toy bowling game were rejected as unpatentable over the prior art and the claims were successively limited in a series of deliberate steps in an effort to persuade the Patent Office Examiner of patentable distinctions over the cited prior art. The full scope of the added limitations to distinguish over

the prior art is readily appreciated by a comparison of patent claims 1 and 4 with original application Claim 4 as seen in the tabulation at Appendix pages 142-145.

### 3. The Accused COLECO Bowling Game

As admitted by COHN, the structure illustrated in Coleco Freeman Patent No. 3,866,691 (Appendix at 146-157) substantially illustrates and the specification substantially describes the BOWL-A-MATIC bowling game of Coleco which is charged to infringe the COHN patent in suit (Response to Admissions No. 1-4, Appendix at 100-101).

As is evident from an examination of the COLECO structure illustrated in the COLECO patent and as perhaps more simply set forth in the affidavit of Dr. David M. Wetstone (Appendix at 174-178), the accused COLECO game does not incorporate significant structural limitations set forth in the claims of the COHN patent.

Turning first to the major portion of the COLECO game which COHN contends is the equivalent of his base plate, as best seen in Figures 1 and 7 of the COLECO patent and as described in the specification, there is an elongated playing surface 16 which has a central flat surface 72 providing the bowling lane which is elevated above the level of the outer side portions of the flat surface 72 to provide gutters along the sides thereof. This central flat surface 72 is also elevated above the level of the ball return chute 140 at the rear portion thereof.



As described in the affidavit of Dr. Wetstone and as indicated by the COLECO patent, the playing surface 16 is nonmetallic and nonmagnetic and has 10 disc-shaped magnets 134 seated in spaced recesses formed therein in a triangular array. As constructed by COLECO, the playing surface is a two-piece construction with a base member of paper chipboard extending the full width thereof, and an elevated member of narrower width providing the flat surface 72, and this elevated member is also made of paper chipboard with a top photographic layer resembling a wood pattern alley. This elevated component provides the gutters on either side.

The COLECO game has a pair of separately formed, vertically extending side panels 74, 76 which have longitudinal slots or channels which receive the side edges of the playing surface 16. As indicated in the Wetstone affidavit, the side panels are made of pressed wood. Obviously, they are not integral with the playing surface and the playing surface itself does not have any upstanding flanges which are integral with its opposite side edges.

At the rearward end of the playing surface 16 is a rear housing 14 which comprises a vertical panel 38 having a pair of vertically spaced horizontal shelf members 40, 42 and a pair of generally vertical side portions 34, 36 extending perpendicularly thereto. This rear housing is secured to the side panels 74, 76 by threaded fasteners and does not extend over the flat surface 72 but only over the depressed ball chute 140.

Secured to the rear housing of the COLECO game and extending over the flat surface 72 are a triangular cone support 118 and a top cover 144 which extends over the cone support 118. Both the cone support and the top cover are rigidly mounted on the rear housing so that they do not move relative to each other or to the playing surface.

Ten bowling pins 102 of nonmagnetic material having magnets 122 in the bases thereof are disposed upon the flat surface 72 over the magnets 120 therein so that the magnetic interaction between the magnets 120, 122 tends to maintain the pins 102 in alignment with the magnets of the flat surface 72 and in upright position thereon.

Nonelastic cords 116 are secured at one end to the tops of the bowling pins 102 and extend upwardly through cone-shaped portions 128 on the cone support 118 through holes in the tops thereof and then rearwardly through holes in the rear housing 14 and thence downwardly. These ends of the cords are secured to vertically disposed springs 114 which in turn are connected to a horizontally disposed vertically movable spring support brace 110. As is clearly shown in the patent drawings, this brace is rearwardly of the rear cover 32 of the rear housing 14 and it is biased upwardly by the springs 112. This brace is movable between two positions as shown in Figure 5 of the patent drawings in response to action of the resetting lever 80 which is operatively connected thereto by the string 50 and always lies below the horizontal plane defined by the planar portion of cone support 118.



Thus, it will be appreciated that the accused COLECO game does not have, inter alia, any of the following elements of structure called for by the COHN patent claims:

1. a flat, substantially rectangularly-shaped metal base plate (Claims 1 and 4);
2. a base plate having upstanding flanges integral with the opposite side edges thereof (Claims 1 and 4);
3. an inverted U-shaped frame extending over the base plate in spaced relation thereto and having the lower opposite edges secured to the upstanding flanges of the base plate (Claims 1 and 4);
4. a supporting member carrying a bowling pin which is positioned above a guide plate secured to the U-shaped frame above the base plate and which supporting member is mounted for movement relative to the base plate (Claims 1 and 4);
5. spring means positioned intermediate the guide plate and the supporting member for normally urging the supporting member away from the base plate and normally urging the supporting member so as to automatically return it and retain it in normal spaced relation above the base plate (Claims 1 and 4); and
6. an elastic string secured to the bowling pin and to the support member (Claims 1 and 4).

#### IV. POINTS ON APPEAL

It is the contention of COHN that the Summary Judgment of Non-infringement should be reversed because there are issues of material fact as to whether there is file wrapper estoppel and as to whether the COLECO product is equivalent to any specifically defined in the COHN claims. Moreover, COHN contends that the Doctrine of File Wrapper Estoppel is itself an issue of fact so that he presents as the issue for review the question "Is there any genuine issue as to any material fact?"

As COLECO argued at the time of the hearing on its Motion for Summary Judgment of Noninfringement, the District Court Judge could, based upon the file wrapper of the patent in suit and the admissions of COHN, conclude that there was file wrapper estoppel as to various limitations of the patent claims which would preclude their expanded interpretation in any effort to encompass the accused COLECO game. Moreover, as pointed out at the time of the original motion, COHN has admitted that the COLECO Freeman patent illustrates the accused game and a review of that patent establishes that it does not have structure corresponding to the limitations of the COHN patent claims.

In addition, COHN's own expert in his affidavit admits that the accused COLECO game does not have the specific elements of structure defined by the COHN patent claims. Accordingly, the Honorable Whitman Knapp on the record before him could and properly did find that there was



no material issue of fact as to whether the claims of the COHN patent read upon the accused COLECO game and that the pertinent limitations of the claims of the COHN patent were subject to application of the Doctrine of File Wrapper Estoppel. Accordingly, the Court could properly and did properly find that the Doctrine of Equivalents could not appropriately be applied where expansion of the claims was precluded by the Doctrine of File Wrapper Estoppel.

It is respectfully submitted that the record below clearly supports the decision of the Honorable Whitman Knapp that there was no genuine issue of fact to be tried. In addition, it is submitted that the overwhelming weight of authority clearly supports the conclusion of law that file wrapper estoppel precludes the application of the Doctrine of Equivalents. For these reasons, it is submitted that the decision of the District Court should be affirmed and the appeal dismissed.

Summary Judgment May Be Granted  
Where There is No Genuine Issue of  
Material Fact

---

Rule 56 Federal Rules of Civil Procedure clearly contemplates that actions should be disposed of at the earliest possible time and authorizes the granting of motions for summary judgment which may be wholly or partially dispositive of the issues in an action. The Court has recognized the desirability of abandoning its earlier philosophy of limiting such motions to the "most extraordinary circumstances", Heyman v. Commerce and

Industry Insurance Co., 524 F.2d. 1317, 1319 (1975), although it has cautioned the District Courts to ensure that there is no issue of fact.

This Court has also recognized that summary judgment is an appropriate remedy in patent litigation. Vermont Structural Slate Co. v. Tatko Bros. Slate Co., 233 F.2d. 9 (1956), cert. den. 352 U.S. 917 (1956). See also 6 Moore's Federal Practice Para. 56.17 [44] (2d Ed. 1974), page 2613 et seq. and the many cases which are cited in Footnote 11 thereof.

Summary judgment has been recognized by this Court as an appropriate remedy in patent litigation where the claims were limited by file wrapper estoppel so as to preclude any finding of infringement. Mastini v. American Telephone & Telegraph et al, 269 F.2d 378 (1966), affirming 236 F.Supp. 310 (SDNY 1964). See also Pittway Corp. v. Trine Mfg. Corp., 183 U.S.P.Q. 675 (SDNY 1974).

Cohn Has Admitted That the Claims  
Do Not Literally Read Upon the  
Coleco Structure

Since COHN has submitted the affidavit of William R. Slinger (Appendix at 183-207) in support of his position and has adopted his statements therein, he is bound by those statements and they clearly establish that the accused COLECO game does not include the limitations of the COHN patent claims. In an effort to argue the "equivalency" of the COLECO structure, Mr. Slinger has recited at length his observations as to modifications of the accused COLECO game, but a modified COLECO game is not the



accused product -- it is the game as made and sold by COLECO. Nevertheless, his observations clearly attest to the fact that the game as made and sold by COLECO does not respond to the patent claims.

As will be pointed out hereinafter, it is the position of COLECO advanced at the time of the hearing on the original motions that the COLECO game does not include six key limitations of the COHN patent claims. Other distinctions could also be argued, but these are the simplest and most readily evaluated and so were those advanced at the time of the original motion.

First of all, the COHN patent claims call for a flat, substantially rectangularly-shaped metal base plate. Claim 1 also requires that the metal base plate be of "magnetic material". As observed by Mr. Slinger in his affidavit, the COLECO playing surface is not of magnetic material or of metal; he states "the playing surface contains magnetic material (ten circular magnets)..." (Appendix at 184). At pages 186 and 188, he discusses modification of the COLECO structure to use sheet metal on the nonmagnetic base or playing surface as the magnetic material and his efforts in this regard are illustrated in the photographs appearing in the Appendix at pages 190-192. Thus, there can be no doubt that COHN recognizes and has admitted that the base of the COLECO game is not sheet metal or magnetic material. The mere inclusion of ten magnets would not produce "an extensive upper surface" for such a structure of nonmetallic material.

In addition, this limitation of the claims requires the base plate to be flat whereas Mr. Slinger's photographs at pages 190-192 (best seen at 191) clearly show that the central surface corresponding to the bowling alley is elevated with respect to the remainder of the top surface, thus providing gutters along the sides thereof and a ball chute at the rear end thereof.

The claims of the COHN patent also require the metal base plate to have upstanding flanges integral with the opposite side edges thereof. As admitted by Mr. Slinger, at Appendix pages 184-185, the side panels of the COLECO game are separate with longitudinal channels therein which receive the side edges of the "bottom member" 16 which in turn provides thereon the elevated playing surface 72. Thus, the playing surface 72 is not received in the side panels and certainly those side panels are not integral with the playing surface and they are not fabricated of metal.

A third limitation of the claims which COLECO contends does not apply to its game is that there be an inverted U-shaped frame extending over the base plate in spaced relation thereto and having its lower opposite edges secured to flanges integral with the base plate. In an effort to find some "equivalent" structure in the COLECO game, Mr. Slinger contends at Appendix page 185 that the rear housing 14 has side portions 34, 36 and a shelf member 40 which forms the shape of an inverted U. However, as seen in the Freeman patent and as seen in the photographs at Appendix pages 190-191, there is a similar shelf member 42 spaced below the shelf member 40 which must also be included in the structure. Accordingly, there is no U-shaped member.



Moreover, the photographs at Appendix pages 192-195 also show that the shelves 40, 42 do not extend over the flat surface 72 but only over the depressed ball return chute of the top surface.

A fourth element of the claims which COLECO contends does not apply to the COLECO structure is the requirement that there be a supporting member carrying a bowling pin which is positioned above a guide plate and spaced therefrom and mounted for movement relative to a base plate. Mr. Slinger contends that the spring support brace 110 is the "supporting member" of the COLECO game (Appendix at 185-188). He admits that the spring support brace is behind the rear housing (Appendix at 185) and his photographs at Appendix pages 196-198 clearly show that it is disposed below the level of the COHN support or guide plate in both the reset and play positions. His photographs at Appendix pages 201-207 show the reconstruction which he attempts in an effort to move the spring support brace to a level above the COHN support, but this is not the structure of the accused COLECO game.

A fifth element of structure defined in the COHN patent claims which COLECO contends is not present in the accused game comprises spring means positioned intermediate of a guide plate and the movable supporting member for normally urging the supporting member away from the base plate. Interestingly enough, Mr. Slinger in his affidavit has not seen fit to characterize or find such a structure in the COLECO game. However, COHN's counsel at page 10 of his Brief refers to the stabilizing springs 112 which are in fact connected between the spring support

brace 110 and the top of the rear housing and which bias the spring support brace upwardly and in the direction of the base following the U-shaped path of the cord/spring elements of the COLECO game. Certainly these springs are not positioned intermediate the COHN support and spring guide plate in the relationship defined by the claims.

Lastly, it is the position of COLECO that the accused games do not include "an elastic string secured to the bowling pin and to said supporting member" as required by the COHN patent claims. The COLECO game structure uses nonextensible strings secured at one end to the bowling pins and at their other end to the biasing springs 114. Mr. Slinger clearly recognizes that these do not comprise elastic strings (Appendix at 186-188) and contends that it would be possible to substitute elastic strings as shown in his photographs at Appendix pages 196-198 and 201-209. However, these same photographs also indicate the result of substituting elastic strings for the spring/cord constructions of the actual COLECO game product, since the cords whip about within the assembly when released from tension.

Thus the affidavit upon which COHN relies in an effort to demonstrate alleged equivalency clearly establishes that the actual game made and sold by COLECO does not fall within the limitations of the COHN patent claims, and COHN is bound by the admissions therein.



The Distinctions of the COLECO  
Game May Also Be Observed  
Independently

As pointed out in the original motion and hereinbefore, COHN has admitted that the structure of the accused COLECO game is substantially as illustrated and described in the Freeman patent. Reference to the patent readily shows that the COLECO structure differs from that claimed in the COHN patent.

Moreover, the affidavit of Dr. David M. Wetstone (Appendix at 174-181) clearly points out the distinctions in materials and structural assembly. It is indeed unfortunate that COHN must attempt to attack the technical competence of someone with such respectable qualifications in technology. Apparently, it is the position of COHN that scientists with high degrees in sophisticated science are therefore incapable of understanding simple mechanical structure.

Whatever the case, the Wetstone affidavit and the Freeman patent also point out the clear distinctions between the accused COLECO game and the claims of the COHN patent.

COHN Admits and The Record Shows  
That the Claims Were Successively  
Narrowed in Scope in Order to Obtain  
Allowance

As has been discussed in detail hereinbefore, COHN originally sought relatively broad protection for what he considered to be his inventive

game. Following initial rejection by the Patent Office Examiner, he cancelled his original broad claim and submitted a new independent claim which contained a number of additional limitations. He stressed the significance of the added limitations, as well as the significance of the use of a flat metal base with the magnets disposed in the bottom of the pins in an effort to distinguish over Lloyd and Cummings which included magnets in the playing surface.

Following rejection of his newly presented claim, he submitted proposed amendments to Claim 17 which would have further defined the function of the spring means which urged the supporting plate away from the base plate. This same amendment argued structural distinctions over the patents to Lloyd, Igou and Hedenskoog.

The Examiner was not persuaded and refused to enter the amendment although he did withdraw the rejection of unpatentability over Lloyd in view of Hedenskoog.

COHN's attorney then had an interview with the Examiner and submitted a new independent claim with additional limitations. He argued the significance of the arrangement of the strings, of the arrangement of the springs to urge the support plate away from the base, and the manner in which the springs functions, i. e., compression as opposed to tension.

Each of the six points of structural distinction discussed in the preceding sections was argued as a significant distinction over the prior art



in an effort to obtain allowance of the patent claims. Specifically added were the requirements that the U-shaped frame extend in spaced relationship over the base plate; that the supporting member be disposed above the guide plate and spaced therefrom and mounted for movement relative to the base plate; the entire recitation with respect to the spring means; and the entire recitation with respect to the upstanding flanges upon the base plate. There can be no question that COHN repeatedly argued the significance of his elastic string arrangement and of his use of a metal base plate cooperating with magnets as opposed to a base which might contain magnets such as in the prior art.

How COHN can now argue that these are not material limitations of his claims is not understood.

The Specification of the COHN Patent  
Must Be Used to Interpret the Claims

The specification of a patent in suit should be reviewed to give meaning to the claims. U.S. v. Adams, 383 U.S. 39 (1966); MacLaren v. B-I-W Group, Inc., 535 F.2d 1367 (2d Cir. 1976).

The claims of a patent cannot be interpreted in a vacuum but must be read in light of the patent specification to determine the meaning intended by the inventor. U.S. Philips Corp. v. National Micronetics, Inc., 410 F.Supp. 449 (SDNY 1976), citing U.S. v. Adams, supra, and Schriber-Schroth Co. v. Cleveland Trust Co., 311 U.S. 211 (1940).

COHN contends that the COLECO structure employs a base plate with integral upstanding flanges within the meaning of his patent claims. However, the specification of his patent and his drawings clearly show his base plate 10 as having its side flanges 11 bent up from the sheet metal of the base plate (Appendix at 42, column 2, lines 1-5). The specification stresses the simplicity of his structure and its assembly.

COHN now contends that COLECO's rear housing comprises an inverted U-shaped frame extending over the base plate within the meaning of his claims. Yet his specification (Appendix at 42, column 2, lines 6-21) clearly describes the nature of the U-shaped frame contemplated as being one overlying substantially his playing surface and as being open at front and rear. This is certainly not the case with the COLECO structure which neither overlies the playing surface nor is open at the rear.

COHN now contends that the supporting member need not be spaced above his guide plate. Yet his specification (Appendix at 43, column 3, lines 39-71) points out the critical relationship between the reset plate 32, subplate 39 and guide plate 34 and the relationship of the springs 36 as functioning therebetween. This structural arrangement was argued in obtaining allowance of patent Claim 1 (Appendix at 91).

Thus, the specification of the COHN patent clearly belies COHN's present efforts to construct broadly his patent claims, ignore their express wording and reconstruct the accused COLECO game.



The Accused Coleco Game Does  
Not Infringe the Claims of the  
Cohn Patent

As has been pointed out in the preceding sections, the COHN patent claims require a series of components disposed in a certain fashion relative to each other, operating in a certain fashion relative to each other, and constructed in a certain fashion, all as defined in the patent claims. An accused device will infringe a claim drawn to a combination of elements only if each element of the claim finds a corresponding element in the accused device. Svenska Aeroplan Aktiebolaget v. Mergenthaler Co., 410 F. 2d 979 (2d Cir. 1969). Since the COLECO structure which has been charged to infringe does not have structural elements corresponding to the six elements which have been discussed hereinbefore, it can not literally infringe those claims. As also pointed out hereinbefore, COHN has admitted that the COLECO device does not literally respond to the limitations of the COHN patent claims; his position has been that the COLECO game employs elements in structure which are the functional equivalent of the elements defined in the COHN patent claims.

However, the law is clear that a patentee is estopped from asserting a scope for his claims which he surrendered in an effort to obtain allowance of those claims. This is the Doctrine of File Wrapper Estoppel which is simply stated :

"The patentee may not recapture, by resort to the doctrine of equivalents, claim coverage he surrendered by amendment in order to overcome

a rejection of the claims as unpatentable over the prior art."

Pittway, supra at 1677.

This principle of file wrapper estoppel has long been established and recognized by the United States Supreme Court and the Courts of Appeals of the many circuits. Schriber-Schroth Co. v. Cleveland Trust Co., 311 U.S. 211 (1940); Graham et al., Petitioners, v. John Deere Company et al., 383 U.S. 1 (1966); General Instrument Corporation v. Hughes Aircraft Company, 399 F. 2d 373 (1st Cir. 1968); International Latex Corporation v. Warner Brothers Company, 276 F. 2d 557 (2nd Cir. 1960) cert. denied, 364 U.S. 816 (1960); Schmidinger et al v. Welsh et al., 383 F. 2d 455 (3rd Cir. 1967); Power Curbers Inc. v. E. D. Etnyre & Co. et al., 298 F. 2d 484 (4th Cir. 1962); Rosen v. Kahlenberg 474 F. 2d 858 (5th Cir. 1973); Kaiser Industries Corp. et al v. McLouth Steel Corporation, 400 F. 2d 36 (6th Cir. 1968); Arvin Industries, Inc. v. Berns Air King Corp. 525 F. 2d 182 (7th Cir. 1975); Burgess & Associates, Inc. v. Klingensmith, 487 F. 2d 321 (9th Cir. 1973).

Moreover, it has long been accepted that a finding of file wrapper estoppel with respect to any limitation of the claims precludes resort to the Doctrine of Equivalents in an effort to encompass the accused structure. This was recognized in Pittway, supra, cited by the Honorable Whitman Knapp in his decision and it is clearly the law of this Circuit and elsewhere.

In Schriber-Schroth Co., supra at 221, the Supreme Court stated:



"The patentee may not, by resort to the doctrine of equivalents, give to an allowed claim a scope which it might have had without the amendments; the cancellation of which amounts to a disclaimer."

This Court enunciated the principle in International Latex Corp., supra, at 565:

"However, we must look at the patent office history and, when we do, we find that even so modest an expansion of the claim by the doctrine of equivalents is precluded by 'file-wrapper estoppel' . . . It is settled that the rejection of a claim forbids 'any interpretation of those secured which leaves them identical with that rejected' or any use of the doctrine of equivalents to that end."

A cursory review of the comparison of the claims of the original application with the claims of the issued patent as seen at Appendix pages 142-145 will establish that most of the six limitations contended by COLECO not to encompass its accused game were added during the course of prosecution before the Patent and Trademark Office. Whether they were providently added or not is not the issue here because COHN can not expect this Court to determine whether they should have been added to obtain allowance of the claims. The fact of the matter is that they were added and they were argued to obtain allowance of an application which had been finally rejected by the Patent and Trademark Office as unpatentable over the prior art. The COHN patent is not directed to a "pioneer invention" as COHN would have this Court believe; it was at best a minor advance in a reasonably well developed art.

Assuming that the Doctrine of File Wrapper Estoppel were limited to elements of the claims which had not been originally presented, as COHN contends, applying this limited doctrine would establish non-infringement of the COHN patent claims since the COLECO structure does not have, inter alia, :

1. a base plate with upstanding flanges integral with the opposite side edges thereof;
2. an inverted U-shaped frame extending over said base plate in spaced relation thereto;
3. a supporting member positioned above a guide plate and spaced therefrom and mounted for movement relative to the base plate;
4. spring means positioned intermediate the guide plate and the supporting member for normally urging the supporting member away from the base plate.

However, the Doctrine of File Wrapper Estoppel is not merely limited to elements of the claims which were added in an effort to distinguish over the prior art. The concept is that the patentee should not be permitted to ignore any limitation which he argued as being essential to his invention in an effort to distinguish over the prior art.

In Capri Jewelry Incorporated et al v. Hattie Carnegie Jewelry Enterprises, Ltd. et al, 539 F. 2d 846 (1976), this Court cited with approval the decision in International Latex Corp., supra. In considering



the claim which itself had not been narrowed by amendment, this Court distinguished Moore Business Forms, Inc. v. Minnesota Mining and Manuf. Co., 521 F. 2d 1178 (2nd Cir. 1975) upon which the Plaintiff relies:

"That opinion should not be read to make this point all-important; immediately following the language quoted to us, the court also pointed out that there had never been an attempt to distinguish the claim being there sued upon from the prior art on the basis of the unique qualities of the feature as to which equivalence was being asserted--exactly what appellant is seeking to do here."

Thus, although the limitation with respect to the flat metal base plate and the elastic string were present in Claim 4 as originally filed, the file wrapper clearly indicates that these limitations were argued as critical limitations in distinguishing over the prior art. COHN is now estopped to argue that those limitations can be ignored in an effort to find equivalent elements in COLECO's accused game.

## V. CONCLUSION

From the file history of the patent in suit, the COLECO patent which has been admitted to describe the accused game, the affidavit of the COHN expert, and the admissions of COHN, it is clear that there are no factual issues with respect to the actual structure of the accused COLECO game and its distinctions from the limitations expressed in the claims of the COHN patent.

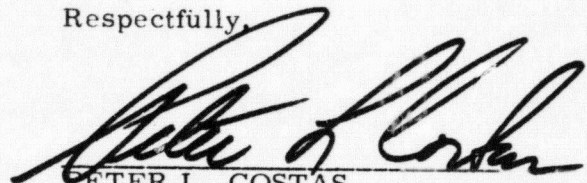
The issue of file wrapper estoppel requires reference only to the file history of the COHN application and the cited prior art, all of which are of record; no expert testimony is required to interpret the admissions and the arguments of COHN. Accordingly, it is submitted that there are no material issues of fact required for determination of whether file wrapper estoppel prevents a broadening of the COHN patent claims to encompass the COLECO game structure which admittedly does not fall within the literal language of those claims.

The Doctrine of File Wrapper Estoppel has long been established and has long been recognized as preventing a patentee from doing what COHN attempts to do here -- to encompass an accused device by ignoring limitations argued before the United States Patent Office. Moreover, the Doctrine of File Wrapper Estoppel precludes resort to the Doctrine of Equivalents and so there is no necessity to reach the factual issues which COHN argues as making summary judgment inappropriate at this time.



Accordingly, it is respectfully submitted that the judgment of the District Court should be affirmed and the appeal dismissed.

Respectfully,

A handwritten signature in dark ink, appearing to read "Peter L. Costas", written over a horizontal line.

PETER L. COSTAS  
Attorney for Appellee  
Three Lewis Street  
Hartford, Connecticut 06102  
(203) 278-9892

OF COUNSEL:

Stanley L. Kantor  
Forsythe, LeViness & Pearson  
375 Park Avenue  
New York, New York 10022  
(212) 759-4300

LAW OFFICES  
PETER L. COSTAS  
3 LEWIS STREET  
HARTFORD, CONN. 06103  
AREA CODE 203 278-9892

March 10, 1977

Clerk, United States Court of Appeals  
Second Circuit  
Foley Square  
New York, New York

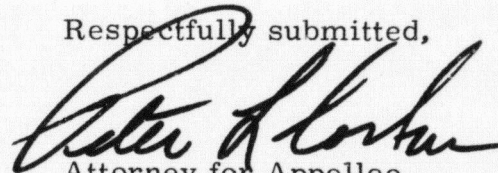
Dear Sir:

David Cohn v. Coleco Industries, Inc.  
Appeal No. 76-7563

Pursuant to scheduling order No. 3 in the captioned appeal,  
enclosed herewith are ten (10) copies of Appellee's brief.

By copy of this letter, the brief is being served by first class  
mail upon both counsel for Appellant.

Respectfully submitted,

  
Attorney for Appellee

PLC/lf

enclosures

cc: K.E. Macklin, Esq.  
P.H. Heller, Esq.  
S.L. Kantor, Esq.  
M.S. Schwefel, Esq.